

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHIN-ICHI TSUBOI,
ATSUMI KAMOUCHI, NOBUHIRO YAMASHITA,
IKUYA SAITO, YUZURU WADA, KUNIHIRO ISONO,
and SHIGEHARU KOYAMA

Appeal No. 95-2976
Application 08/041,077¹

HEARD: Dec. 7, 1998

Before JOHN D. SMITH, GARRIS, and WARREN, Administrative
Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed April 1, 1993.

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This is a decision on an appeal from the final rejection of claims 4 through 20 which are all of the claims remaining in the application.²

The subject matter on appeal relates to a process for the treatment of a plant which comprises introducing into a sap conduction path of the plant a solid shaped treatment article comprising a treatment agent contained in a carrier material. Further details of this appealed subject matter are set forth in illustrative independent claims 4 and 16 which read as follows:

4. A process for the treatment of a plant which comprises introducing into the region of a sap conduction path of the plant a solid shaped treatment article comprising a treatment agent contained in a carrier material as a matrix, the carrier material being selected from the group consisting of a solid degradable organic substance and a polymeric carrier material.

16. A material for the treatment of a plant which comprises a treatment agent contained in a solid shaped carrier material as a matrix, the carrier material being selected from the group consisting of a solid degradable organic substance and a polymeric carrier material.

² We consider the section 112, first paragraph, rejection set forth in the final office action to have been withdrawn by the examiner since it has not been repeated in the answer. See Manual of Patent Examining Procedures section 1208, page 1200-14 (7th edition, July 1998).

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The references relied upon by the examiner in the rejections before us are:

Renner et al. (Renner)	1,661,577	Mar. 6, 1928
Bahadir et al. (Bahadir)	4,743,448	May 10, 1988
Shiokawa et al. (Shiokawa)	5,034,524	Jul. 23, 1991
Carlson et al. (Carlson)	5,157,207	Oct. 20, 1992
Itzel et al. (European '196) (EP)	0,254,196	Jan. 27, 1988

Claims 4, 6 and 8 through 10 stand rejected under the second paragraph of 35 U.S.C. § 112 for failing to particularly point out and distinctly claim the subject matter which the appellants regard as their invention.

Claims 4, 6, 8, 12, 15 and 16 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Renner.

Finally, claims 4 through 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Renner or Renner in view of European '196 or Renner in view of Carlson and Bahadir and Shiokawa.

As a preliminary matter, we observe that the appellants have grouped the claims on appeal in accordance with their

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groupings in the above noted rejections; see page 5 of the brief and 37 CFR § 1.192(c)(5)(1993). Accordingly, in our assessment of the prior art rejection before us, we will focus upon independent claims 4 and 16 (the sole independent claims on appeal) with which all other rejected claims will stand or fall.

OPINION

For the reasons which follow, we will sustain the above noted prior art rejections but not the section 112, second paragraph, rejection.

On page 3 of the answer, the examiner expresses his section 112, second paragraph, position in the following manner;

Degradable organic and polymeric are indefinite terms, as is "derivative" without specification of type i.e. - ester, etc. Claim 9; or terms do not clearly modify polyether diamine. Claim 10 is not clear as to the Markush species - are all polyesters?

It is well settled that the definiteness of claim language must be analyzed, not in a vacuum but, always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art.

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In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). On this record, the examiner has not so analyzed the language of the appealed claims and thus has not carried his burden of establishing a prima facie case of indefiniteness. For example, the examiner has advanced utterly no rationale, and we discern none independently, for his position that claim terms such as "degradable", "organic" and/or "polymeric" are indefinite terms. It follows that we cannot sustain the examiner's section 112, second paragraph, rejection of claims 4, 6 and 8 through 10. However, we will sustain the section 102(b) rejection of claims 4, 6, 8, 12, 15 and 16 as being anticipated by Renner. This is because we perceive no distinction in process claim 4 or material claim 16 relative to the process and material described in the Renner patent particularly at lines 4 through 16 in the right hand column on page 2. Specifically, the solid shaped treatment article of claim 4 and the material of claim 16 appear to be indistinguishable from the solid shape described on page 2 of Renner.

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Moreover, since anticipation is the epitome of obviousness (In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982)), we will also sustain the examiner's section 103 rejection of claims 4 through 20 as being unpatentable over Renner or Renner in view of European '196 or Renner in view of Carlson and Bahadir and Shiokawa.

The decision of the examiner is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

	John D. Smith)	
	Administrative Patent Judge)	
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)	
	Bradley R. Garris)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
	Charles F. Warren)	
	Administrative Patent Judge)	

tdc

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